

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No.: 37965-0021

Applicant(s): Paul JACKSON et al.

Confirmation No.: 3359

Appl. No.: 10/720,992

Examiner: To be assigned

Filing Date: November 25, 2003

Group Art Unit: 1614

Title: Dipeptidyl Peptidase IV Inhibitors and Methods of Making and Using  
Dipeptidyl Peptidase IV Inhibitors

**INFORMATION DISCLOSURE STATEMENT  
UNDER 37 CFR §1.56 and 37 CFR §1.97**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Submitted herewith on Form PTO/SB/08A is a listing of documents known to applicants in order to comply with applicants' duty of disclosure pursuant to 37 C.F.R. §1.56 and §1.97. A copy of each of the listed documents are being submitted to comply with the provisions of 37 C.F.R. §1.97-1.99.

The submission of any document herewith, which is not a statutory bar, is not intended as an admission that such document constitutes prior art against the claims of the present application or is considered to be material to patentability as defined in 37 C.F.R. §1.56(b). Applicants do not waive any rights to take any action which would be appropriate to antedate or otherwise remove as a competent reference any document which is determined to be a *prima facie* prior art reference against the claims of the present application.

Applicants believe that the instant Information Disclosure Statement is being filed before the mailing of a first Office Action on the merits under 37 CFR §1.97(b)(3), therefore, no fee is required in connection with its filing.

Applicants submit herewith on the attached PTO/SB/08A forms and Form PTO-892, a listing of the documents cited by or submitted to the Patent Office in parent applications Serial No. 09/709,383 filed November 13, 2000 and Serial No. 09/439,089 filed November 12, 1999. The relevance of these prior art documents is explained in the parent application.

As provided in 37 C.F.R. §1.98(d), copies of the documents are not being provided since they were previously cited by or submitted to the Patent Office in parent applications Serial No. 09/709,383 filed November 13, 2000 and Serial No. 09/439,089 filed November 12, 1999.

Applicants respectfully request that the listed documents be considered by the Examiner and be made of record in the present application and that an initialed copy of Form PTO/SB/08A be returned in accordance with M.P.E.P. §609.

Respectfully submitted,



John P. Isacson  
Reg. No. 33,715

March 18, 2004  
Date

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FORM PTO 1449 (modified)

ATTY DOCKET NO.  
36849/110SERIAL NO.  
To be assignedU.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICEAPPLICANT  
Paul JACKSON *et al.*LIST OF REFERENCES CITED BY APPLICANT(S)  
(Use several sheets if necessary)FILING DATE  
Concurrently herewithGROUP  
To be assigned

## U.S. PATENT DOCUMENTS

*EXAMINER INITIAL		DOCUMENT NUMBER	DATE (M/D/Y)	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
	A01	5,874,449	2/23/99	HAMILTON ET AL.	514	330	
	A02	5,543,396	8/6/96	POWERS ET AL.	514	19	
	A03	5,804,602	9/8/98	SLUSHER ET AL.	514	574	

## FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER	DATE (M/D/Y)	COUNTRY	CLASS	SUBCLASS	TRANSLATION YES NO	
	A04	WO94/03055	2/17/94	WIPO				
	A05	WO95/11689	5/4/95	WIPO				
	A06	WO95/34538	12/21/95	WIPO				
	A07	WO97/40832	11/6/97	WIPO				
	A08	WO98/19998	5/14/98	WIPO				

## OTHER DOCUMENT(S) (Including Author, Title, Date, Pertinent Pages, Etc.)

	A09	AUGUSTYNS ET AL.	CURRENT MEDICINAL CHEMISTRY 6: 311-327 (1999)
	A10	BARNES ET AL.	EUROPEAN JOURNAL OF NEUROSCIENCE 6: 531-537 (1994)
	A11	BELIAEV ET AL.	STRUCTURE-ACTIVITY RELATIONSHIP OF DIARYL PHOSPHATE ESTERS AS POTENT IRREVERSIBLE DIPEPTIDYL PEPTIDASE IV INHIBITORS (DIALOG ABSTRACT 11965656/6)
	A12	BELIAEV ET AL.	J. MED. CHEM. 42: 1041-1052 (1999)
	A13	BOGENRIEDER ET AL.	THE PROSTATE 33: 225-232 (1997)
	A14	DE BOER ET AL.	DRUG TRANSPORT ACROSS THE BLOOD-BRAIN BARRIER, HARWOOD ACADEMIC PUBLISHERS, PGS. 59-67
	A15	GLAESKE ET AL.	ORGANIC LETTERS 1(1): 31-33 (1999)
	A16	LIN ET AL.	PROC. NATL. ACAD. SCI. USA 95: 14020-14024 (1998)
	A17	MENTZEL ET AL.	JOURNAL OF HISTOCHEMISTRY AND CYTOCHEMISTRY 44(5): 445-461 (1996)
	A18	NGUYEN ET AL.	J. MED. CHEM. 41: 2100-2110 (1998)
	A19	OLEKSYSYN ET AL.	INTL. JOURNAL OF METHOD IN SYNTHETIC ORGANIC CHEMISTRY, PGS. 479-480 (1978)
	A20	PANGALOS ET AL.	J. BIOL. CHEM. 274(13): 8470-8483 (1999)
	A21	REINHOLD ET AL.	IMMUNOLOGY 91: 354-360 (1997)
	A22	SHVALOFF ET AL.	LINES OF THERAPEUTICS RESEARCH IN ALZHEIMERS-DISEASE (DIALOG ABSTRACT 05335738/5)

EXAMINER

DATE CONSIDERED

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

SERIAL NO.  
To be assigned

**GROUP**  
**To be assigned**

*EXAMINER INITIAL		DOCUMENT NUMBER	DATE (M/D/Y)	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE

[illegible][illegible]

DATE CONSIDERED

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Approved for use through 10/31/2002. OMB 0651-0031<sup>5</sup>

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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**Complete if Known**

Application Number	09/709,383
Filing Date	November 13, 2006
First Named Inventor	JACKSON, Paul
Group Art Unit	1614
Examiner Name	To be Assigned
Attorney Docket Number	37965-0006

*(use as many sheets as necessary)*

Sheet	1	of	1
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Date Considered

<sup>1</sup> Unique citation designation number. <sup>2</sup> See attached Kinds of U.S. Patent Documents. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.

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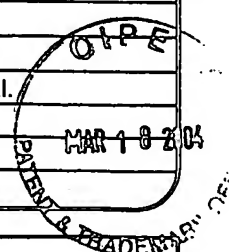
# INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(use as many sheets as necessary)

Sheet 1 of 2

## Complete if Known

Application Number 09/709,383  
Filing Date November 13, 2000  
First Named Inventor Paul JACKSON et al.  
Group Art Unit 1617  
Examiner Name R. Travers  
Attorney Docket Number 37965-0006



## U.S. PATENT DOCUMENTS

Examiner Initials *	Cite No. <sup>1</sup>	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number - Kind Code <sup>2</sup> (if known)			
	B1	US-5,939,560	08/17/1999	Jenkins et al.	
	B2	US- 6,011,155	01/04/2000	Villhauer	
	B3	US- 6,107,317	08/22/2000	Villhauer	
	B4	US- 6,110,949	08/29/2000	Villhauer	
	B5	US- 6,124,305	09/26/2000	Villhauer	
	B6	US- 6,166,063	12/26/2000	Villhauer	
	B7	US- 6,172,081	01/09/2001	Damon	
	B8	US- 6,201,132	03/13/2001	Jenkins et al.	
	B9	US- 6,211,384	04/03/2001	Fitt, Sr. et al.	
	B10	US- 6,380,398	04/30/2002	Kanstrup et al.	
	B11	US- 6,432,969	08/13/2002	Villhauer	
	B12	US- 6,521,644	02/18/2003	Broqua	
	B13	US- 6,211,384	04/03/2001	Fitt, Sr. et al.	
	B14	US- Pub. No. 2001/0031780	10/18/2001	Kanstrup et al.	
	B15	US- Pub. No. 2002/0103384	08/01/2002	Kanstrup et al.	
	B16	US- Pub. No. 2002/0183367	12/05/2002	Sulsky et al.	
	B17	US- Pub. No. 2002/0161001	10/31/2002	Kanstrup et al.	
		US-			
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## FOREIGN PATENT DOCUMENTS

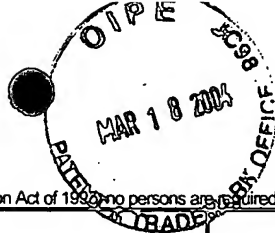
Examiner Initials *	Cite No. <sup>1</sup>	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T <sup>6</sup>
		Country Code <sup>3</sup> - Number <sup>4</sup> - Kind Code <sup>5</sup> (if known)				
	B18	EP 1 082 314 B1	05/28/1999	Probiobdrug AG		
	B19	EP 1 258 480 A1	11/20/2002	Eisai Co. Ltd.		
	B20	WO 95/11689	05/04/1995	Trustees of Tufts College		
	B21	WO 95/15309	06/08/1995	Ferring B.V.		
	B22	WO 98/19998	05/14/1998	Novartis AG		
	B23	WO 99/61431	12/02/1999	Pro Biodrug		
	B24	WO 99/67278	12/29/1999	Pro-Biodrug		
	B25	WO 99/67279	12/29/1999	Pro-Biodrug		
	B26	WO 00/34241	06/15/2000	Novartis AG		

Examiner Signature		Date Considered	
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<sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04.

<sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.



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Sheet 2 of 2

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Attorney Docket Number	37965-0006

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		Country Code <sup>3</sup> - Number <sup>4</sup> - Kind Code <sup>5</sup> (if known)				
	B27	WO 00/56297	09/28/2000	Ferring B.V.		
	B28	WO 01/555105 A1	08/02/2001	Novo Nordisk A/S		
	B29	WO 01/68603 A2	09/20/2001	Bristol-Myers Squibb		
	B30	WO 01/81304 A1	11/01/2001	Ferring BV		
	B31	WO 01/81337 A1	11/01/2001	Ferring B.V.		
	B32	WO 01/96295 A2	12/20/2001	Novartis AG		
	B33	WO 02/02560 A2	01/10/2002	Novo Nordisk A/S		
	B34	WO 02/2560 A3	01/10/2002	Novo Nordisk A/S		
	B35	WO 02/14271 A1	02/21/2002	Welfide Corp.		
	B36	WO 02/20825 A1	03/14/2002	The Research Foundation of State University of New York		
	B37	WO 02/30890 A1	04/18/2002	Tanabe Seiyaku Co., Ltd.		
	B38	WO 02/38541 A1	05/16/2002	Taisho Pharmaceutical Co. Ltd.		
	B39	WO 02/051836 A1	04/07/2002	Kyowa Hakko Kogyo Co.		
	B40	WO 02/067918 A1	06/09/2002	Banyu Pharmaceutical Co., Ltd.		
	B41	WO 02/068420 A1	09/06/2002	Boehringer Ingelheim Pharma KG		
	B42	WO 03/000180 A2	01/03/2003	Merck & Co., Inc.		
	B43	WO 03/000181 A2	01/03/2003	Merck & Co., Inc.		
	B44	WO 03/000250 A1	01/03/2003	Ferring BV		
	B45	WO 03/002530 A2	01/09/2003	Smithkline Beecham		
	B46	WO 03/002532 A2	01/09/2003	Smithkline Beecham		
	B47	WO 03/002553 A2	01/09/2003	Smithkline Beecham		
	B48	WO 03/004496 A1	01/16/2003	Novo Nordisk A/S		
	B49	03/004498	01/16/2003	Merck & Co., Inc.		

Examiner  
Signature

Date  
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